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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/685,079	10/06/2000	Jay S. Walker	00-039	3152

7590

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EXAMINER

MCALLISTER, STEVEN B

ART UNIT

PAPER NUMBER

3627

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/685,079

Applicant(s)

WALKER ET AL.

Examiner

Steven B. McAllister

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36,38 and 39 is/are pending in the application.
- 4a) Of the above claim(s) 3,8 and 10-12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7,9,13-36,38 and 39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ✓ 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/2000/12/2002 ✓
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of claims 1, 2, 4-7, 9, 13-36, 38 and 39 in the reply filed on 10/7/2005 is acknowledged.

Claims 3, 8 and 10-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 10/7/2005.

With respect to claim 25, the examiner concurs with applicant's argument, and claim 25 is rejoined with the claims elected without traverse.

Double Patenting

Claims 1, 2, 4-7, 9, 13-36, 38 and 39 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,415,262.

As to claims 1, 2, 4-7, 13-15, 23, 25-28, 31-36, 38 and 39, although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ only in scope.

As to claims 9, 13 and 14, the claims of '262 show all elements of the claims except that the security deposit comprises a reduction of an amount of credit available to the customer via a credit card. However, the examiner takes official notice that to provide a security deposit in such a manner is notoriously old and well known in the art (e.g., providing a security deposit against a credit card when renting a car, the security

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deposit reducing the amount of credit available on the card.) It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by providing the deposit in this way in order to take advantage of the existing credit card system.

As to claims 16-24, the claims of '262 show all elements except the information taken into account in determining the deposit. However, the examiner takes official notice that the use of the claimed information in determining the deposit, as claimed, is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by using the recited information in order to provide an appropriate deposit amount, related to the particular circumstances of the transaction.

As to claim 29, the claims of '262 show all elements except verifying the information. However, the examiner takes official notice that to verify received information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of the claims of '262 by doing so in order to ensure that the information is correct.

As to claim 30, the claims of '262 show all elements of the claim except that the information comprises a hash value. However, the examiner takes official notice that providing a hash value is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate secure communication.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 2, 4-7, 13-15, 23, 25-28, 31-36, 38 and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Walker et al (6,415,262).

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

As to claims 1, 33, 36, 38 and 39, it is noted that ‘262 shows all elements, including that the task is associated with a party other than the merchant, since the ‘262 shows purchasing subscription goods at a plurality of merchants of a same chain (see e.g., col. 4, lines 35-40), and also because as contemplated by the specification of the

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present application a task associated with a party "other than the merchant" encompasses a task associated with the merchant and a third part (e.g., p. 8, lines 14-17 of the spec.). It is noted that the task of purchasing a plurality of items over time is associated at least with an item manufacturer as well as the seller.

As to claims 2, 4-7, 13-15, 23, 25-28, 31, 32, 34, and 35, it is noted that '262 shows all elements.

Claims 1, 2, 4, 7, 15, 25, 27, 28, 31, 32 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al (5,870,459).

Phillips shows arranging via a processing device for a benefit to be applied to a transaction, the benefit being the temporary provision of wireless phone in conjunction with the purchased communication time, in exchange for a future performance of a task associated with a third party, comprising returning the phone (it is noted that the phone can be returned to a third party via the mail). Phillips also shows providing the benefit before performance of the task; arranging for the security deposit, and arranging for the return of the security deposit upon performance of the task.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 13, 14, 16-22, 24, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al ('262).

As to claims 9, 13 and 14, '262 shows all elements of the claims except that the security deposit comprises a reduction of an amount of credit available to the customer via a credit card. However, the examiner takes official notice that to provide a security deposit in such a manner is notoriously old and well known in the art (e.g., providing a security deposit against a credit card when renting a car, the security deposit reducing the amount of credit available on the card.) It would have been obvious to one of ordinary skill in the art to modify the method of '262 by providing the deposit in this way in order to take advantage of the existing credit card system.

As to claims 16-24, '262 shows all elements except the information taken into account in determining the deposit. However, the examiner takes official notice that the use of the claimed information in determining the deposit, as claimed, is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '262 by using the recited information in order to provide an appropriate deposit amount, related to the particular circumstances of the transaction.

As to claim 29, '262 shows all elements except verifying the information. However, the examiner takes official notice that to verify received information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of '262 by doing so in order to ensure that the information is correct.

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As to claim 30, '262 shows all elements of the claim except that the information comprises a hash value. However, the examiner takes official notice that providing a hash value is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate secure communication.

Claims 9,13, 14, 16-24, 29, 30 and 33-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al.

As to claim 9, 13, 14, Phillips shows all elements of the claims except that the security deposit comprises a reduction of an amount of credit available to the customer via a credit card. However, the examiner takes official notice that to provide a security deposit in such a manner is notoriously old and well known in the art (e.g., providing a security deposit against a credit card when renting a car, the security deposit reducing the amount of credit available on the card.) It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by providing the deposit in this way in order to take advantage of the existing credit card system.

As to claims 16-24, Phillips shows all elements except the information taken into account in determining the deposit. However, the examiner takes official notice that the use of the claimed information in determining the deposit, as claimed, is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by using the recited information in order to provide an appropriate deposit amount, related to the particular circumstances of the transaction.

As to claim 29, Phillips shows all elements except verifying the information. However, the examiner takes official notice that to verify received information is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to modify the method of Phillips by doing so in order to ensure that the information is correct.

As to claim 30, Phillips shows all elements of the claim except that the information comprises a hash value. However, the examiner takes official notice that providing a hash value is notoriously old and well known in the art. It would have been obvious to one of ordinary skill in the art to do so in order to facilitate secure communication.

As to claims 33-35, Phillips shows all elements except an apparatus that arranges for the performed steps. However, the examiner takes official notice that it is notoriously old and well known to provide an apparatus to perform the recited steps (e.g., a computerized system that dispenses and tracks the return of the phones). It would have been obvious to one of ordinary skill in the art to do so in order to reduce the amount of manual work required and to reduce error by automatic tracking.

As to claim 36, Phillips shows all elements except software performing the performed steps. However, the examiner takes official notice that it is notoriously old and well known to provide software to perform the recited steps (e.g., a computerized system that dispenses and tracks the return of the phones). It would have been obvious

to one of ordinary skill in the art to do so in order to reduce the amount of manual work required and to reduce error by automatic tracking.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven B. McAllister whose telephone number is (571) 272-6785. The examiner can normally be reached on M-Th 8-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander G. Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Steven B. McAllister

Steven B. McAllister
Primary Examiner
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